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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,840	07/06/2001	Mark Leslie Smythe	36677.8	8048
27683	7590	01/08/2007	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			KAM, CHIH MIN	
			ART UNIT	PAPER NUMBER
			1656	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/08/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/787,840	SMYTHE ET AL.	
	<b>Examiner</b> Chih-Min Kam	<b>Art Unit</b> 1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 October 2006.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5,7-31,35,39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5,7-10,14,15,17,18,20,22,24-31,35,39 and 40 is/are rejected.
- 7) Claim(s) 11-13,16,19,21 and 23 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 March 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>10/25/06</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Status of the Claims***

1. Claims 1-5, 7-31, 35 and 39-40 are pending.

Applicant's amendment filed October 25, 2006 is acknowledged, and applicants' response has been fully considered. Claims 1, 7, 14, 17, 22, 24, 26-28 and 30 have been amended, and claim 6 has been cancelled. Therefore, claims 1-5, 7-31, 35 and 39-40 are examined.

### ***Oath/Declaration***

2. A new oath or declaration filed on October 25, 2006 is acknowledged.

### **Withdrawn-Claim Objections**

3. The previous objection of claim 7 is withdrawn in view of applicant's amendment to the claim, and applicant's response at page 18 in the amendment filed October 25, 2006.

### **Withdrawn Claim Rejections - 35 U.S.C. § 112**

4. The previous rejection of claims 1-31, 35 and 39-40 under 35 U.S.C. § 112, second paragraph (see paragraphs 11-20 in the previous Office Action dated May 25, 2006), is withdrawn in view of applicant's amendment to the claim, and applicant's response at pages 18-22 in the amendment filed October 25, 2006.

### ***Claim Objection***

5. Claim 1 is objected to because of the use of the term "by activating the carboxylic acid group of the amino acid, or of a peptide which is to be cyclized or modified", since this is one of the method steps, the word "by" should be deleted. Appropriate correction is required.

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6. Claim 14 is objected to because of the use of the term "thereby to facilitate conversion of the amine to an amide activating the C-terminal carboxylic acid group of the peptide", since this is one of the method steps, a comma "," should be inserted between "amide" and "activating". Appropriate correction is required.

***New Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-5, 7-10, 14, 15, 17, 18, 20, 22, 24-31, 39 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 1-5, 7-10, 14-15, 17, 18, 20, 22, 24, 26-31, 35, 39 and 40 are indefinite as to which group in General Formula II is linked to a primary amine nitrogen atom of an amino acid or a peptide to form a secondary amine, since Z (which allows the formation of carbon-nitrogen bond), or, R<sup>3</sup>, R<sup>4</sup> or R<sup>5</sup> (which can be substituted alkyl group such as halogenated alkyl group) can be the group forming carbon-nitrogen bond. Claims 2-5, 7-10, 15, 17, 18, 20, 22, 24, 26-31, 39 and 40 are included in the rejection because they are dependent on rejected claims and do not correct the deficiency of the claim from which they depend.

9. Claim 15 is indefinite because the claim does not further limit claim 14, which has XH at position 2 and NO<sub>2</sub> as Y at position 6 in Formula III. Claim 35 is included in the rejection because it is dependent on a rejected claim and does not correct the deficiency of the claim from which it depends.

10. Claims 24 and 25 are indefinite because of the use of the term "linking an auxiliary compound as defined in claim 1 to one or more nitrogen atoms in peptide bonds of a starting peptide linked to a solid support", it is not clear how the auxiliary compound can link to the nitrogen of the peptide bonds since claim 1 indicates the auxiliary compound is linked to the primary amine of the peptide. Claim 25 is included in the rejection because it is dependent on a rejected claim and does not correct the deficiency of the claim from which it depends.

***Claim Objections***

11. Claims 11-13, 16, 19, 21 and 23 are objected to because the claims are dependent from a rejected claim.

***Conclusion***

12. Claims 1-5, 7-10, 14, 15, 17, 18, 20, 22, 24-31, 35, 39 and 40 are rejected; and claims 11-13, 16, 19, 21 and 23 are objected to.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

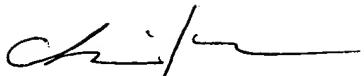
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Bragdon can be reached at 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Chih-Min Kam, Ph. D.  
Primary Patent Examiner



CHIH-MIN KAM  
PRIMARY EXAMINER

CMK

January 2, 2007